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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/273,021	03/19/1999	HAROLD W. MILTON JR.	MILT.777	6459

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EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 07/08/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/273,021

Applicant(s)

MILTON, HAROLD W.

Examiner

Stephen S. Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,10,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3,10,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 3/1/04 to the application, filed on March 19, 1999

2. Claims 1, 3, 10, 19 and 20 are pending in the case. Claims 1, 19 and 20 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 10, 19 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al (US 6,434,580-B1) in view of Nehab (US 6,029,182), Simpson (Mastering WordPerfect 5.1 & 5.2 for Windows™), and Manual of Patent Examining Procedure, 7th edition, published July 1998, herein known as MPEP.

Regarding independent claim 1, Takano discloses *drafting and preparing patent specifications* (title). In his abstract, Takano discloses, *A client computer 100 enters with a draft preparation means 100 a piece of draft data prepared by an inventor, and transmits with a draft uploading means 103 the draft data and a piece of invention report information to a server computer 300. The server computer 300 receives with a draft receiving means 301 the transmitted pieces of draft data and invention report information, and enters them with a draft entry means 302 into a specification file 303, the data and the information being associated with each other. A client computer 200 transfers with a draft downloading means 201 the draft data entered in the server*

computer 300, revises with a draft revision means 202 the draft data, and transmits with a draft uploading means 203 the revised draft data to the server computer 300.

With respect to the claimed "document template", Takano discloses a *template downloading means 105* in figure 6, and at column 9. Specifically, at column 9 (lines 11 et seq), Takano discloses:

Referring to FIG. 6, in the second preferred embodiment of the invention, the client computer 100 further includes a template downloading means 105. This template downloading means 105 reads in document data in a specification form for patent application stored in advance in the specification file 303 of the server computer 300 (a form in which the titles of various items and sentence patterns frequently used in a specification are arranged in their respectively prescribed positions so as to allow the specification to be completed by entering sentences to fill blanks) (hereinafter called "template data").

Next will be described in detail the overall operation of this embodiment with reference to FIGS. 6 and 7.

First, the draft preparation means 101 in the client computer 100 actuates text preparation software, such as a known word processor (step B1 in FIG. 7), and further actuates the template downloading means 105 (step B2).

The actuated template downloading means 105 reads in the template data stored in a prescribed position in the specification file 303 of the server computer 300 (step B3).

The draft preparation means 101 further reads the template data, fetched by the template downloading means 105 into the text preparation software (step B4), and completes the draft data for the specification for patent application by having the inventor enter the text data in addition to the template data.

Next, in the same manner as with the first embodiment of the invention, the draft preparation means 101 in the client computer 100 actuates known drawing software (step A2 in

FIG. 2), and prepares the draft data for the specification for patent application by inserting the drawing data into the draft data.

Description of the ensuing actions, which are the same as with the first embodiment, is dispensed with here.

This embodiment of the invention provides the benefit of making ready template data, which make up a specification form for patent application, in the specification file 303 for the inventor using the client computer 100, and enabling the inventor to easily prepare a specification for patent invention.

It is noted that Takano does not expressly disclose the claimed "page breaks" or "footer with attorney identification", or the exact format of the headings. With respect to the page breaks, refer to Simpson's page 242, in which pages breaks are disclosed. It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Simpson with Takano because Takano's invention requires *text preparation software* (see figure 2, element A1). Simpson discloses how to use WordPerfect, a word processing application which constitutes *text preparation software*. Furthermore, page breaks were known to be requirements for filing a patent application.

With respect to the claimed heading formats, they would have been obvious to one of ordinary skill in the art at the time of the invention in view of Takano because the heading formats were known to be requirements for filing a patent application.

With respect to the claimed "footer", Nehab discloses that the outputted formats can have headers and footers, as on column 24, line 53. However, Nehab does not expressly disclose that the footer information will contain the information of the attorney file identification. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add footer information. One of ordinary skill in the art would have been motivated to do this because

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it is notoriously well known to put textual information that is repeated on every page to be placed in a footer.

Furthermore, the following guidelines, found in the MPEP under section 601, illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- © STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).
"Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (I) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Furthermore, the attorney's or agent's full post office address and other contact information must be given in every power of attorney, MPEP 601.02. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the document template formatted to that of the MPEP. One of ordinary skill in the art would have been motivated to do this because document templates are essentially layouts that are pre-created, and a patent template would want to have the layout specified by patent law.

With respect to the limitation, "storing a duplicate set of all of the claims in the computer program, and creating the description by retrieving the duplicate set of claims under the heading of 'DESCRIPTION OF THE PREFERRED EMBODIMENT'", while it is noted that Takano fails to explicitly teach this step, applicant is directed to Takano's columns 2-4 (Summary of Invention) and columns 18-26 (Claims). Clearly, the summary incorporates claim language, with modifications to provide an easier reading of the text. While it is noted that this text has been placed under the heading of Summary of Invention, it would have been obvious to one of ordinary skill in the art at the time of the invention to also place the text under the heading of "DESCRIPTION OF THE PREFERRED EMBODIMENT" since the substance of the claimed invention was (and still is) required to have antecedent basis in the specification.

Furthermore, Takano fails to disclose the claimed search and replace operation. However, however, the MPEP discloses that the abstract may not have legal phraseology like "means" and said," as on MPEP 608.01(b). Furthermore, Simpson discloses (pages 350-356) a search and replace function. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to replace the words in the specification to be grammatically correct and to have a correct format. One of ordinary skill in the art would have been motivated to do this because a patent application should have the format and proper grammar as specified by MPEP.

Takano does not expressly disclose storing the first and second element names, searching for their occurrences, and selecting the numbers identifying the reference numerals and reference element names; however, Takano does disclose activation of drawing software and inserting drawing data into text data at figure 2 (A2, A3). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to store the reference numbers and match them up with their respective element names in view of Takano's disclosure. One of ordinary skill in the art would have been motivated to do this because it was known to be important when verifying figures and references that they have the same format as required by the Patent and Trademark Office, which requires them to correctly match with element names and have proper antecedent basis.

Takano does not expressly disclose alternative phrasing of edit clauses of the duplicate set of claims; however, Takano does disclose revising the text data (as in figure 2). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to intersperse alternative phrasing of edited clauses of the claims. One of ordinary skill in the art would have been motivated to do this because it was well known that much of the specification comes from the claims and vice versa, and if claims were to need correcting or editing then it would most likely need to correlate with the specification in order to prevent antecedent basis problems.

Takano does not expressly disclose "selecting and storing the abstract sentences" as claimed. However, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to do so because it was known that the abstract should contain a succinct description of the claimed invention.

Takano does not expressly disclose drafting sentences for the Technical Field, Prior Art, Summary of the Invention, Related Applications, and the Brief Description of the Drawings. But

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as stated above, the specification requires having all these headings and is further explained in MPEP 601.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the headings and their respective descriptive statements underneath the headings. One of ordinary skill in the art would have been motivated to do this because in order to have an accurate template for patent applications, one would have wanted to properly conform to the current edition of the MPEP.

Takano further discloses verifying all parts of the disclosure in his Summary.

Takano does not expressly disclose always adding the statement, "Other advantages of the present invention will be readily appreciated as the same becomes better understood by reference to the following detailed description when considered in connection with the accompanying drawings wherein: ..."; however, it was notoriously well known at the time of the invention by those of ordinary skill in the art to add a sentence similar to that as is expressed by Takano at column 4 (lines 58-63), *The invention will be understood more fully from the detailed description given below and from the accompanying drawings of preferred embodiments thereof, which, however, should not be regarded as limiting the invention but are only intended for explanation and as aid to understanding.*

Takano does not expressly disclose adding a paragraph before the claims stating to the effect that the invention has *many modifications and variations*; however, it was notoriously well known to have a paragraph before the claims asserting that the invention is limited by the description described. For example, see Takano's column 18 (lines 27-37). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add a statement asserting variations of the invention are possible in light of Takano's teachings. One of ordinary skill in the art would have been motivated to do this because it was notoriously well

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known in the art to include a statement specifying the variability of the invention in regards to the scope of the invention.

Regarding dependent claim 3, refer to the argument above with respect to claim 1.

Regarding dependent claim 10, Takano does not expressly disclose “storing the reference numbers”; however, it would have been obvious to one of ordinary skill in the art at the time of the invention to do so in order to preserve correct correspondence between the drawings, the element numbers, and the description of those elements. Furthermore, Takano does not expressly disclose adding parenthesis around the reference numbers; however, the MPEP 608.01 (m) states that reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add parentheses to the reference numbers in the claims and abstract. One of ordinary skill in the art would have been motivated to do this because as stated before it would be better to place parentheses around reference numbers, and furthermore if the template is for a patent application one would want the layout to coincide with the patent laws as much as possible.

Furthermore, although Takano and MPEP does not explicitly teach “automatically shifting the reference numerals in response to changing the order of occurrence in the duplicate set of claims, it should be note that it was extremely well known in the art of patent specification drafting to make sure the reference numbers to be presented in the order of the description of the Figures in the “Detailed Description” section of the specification. Therefore, the act of “automating” such feature would have been obvious to a person of ordinary skill in the art at the

time of the invention, since Takano provided the technical features for automatic document creating, and a person of ordinary skill would have appreciated the "automatization" of the reference numbering process.

Regarding independent claims 19-20 are a method and a computer program and computer directed to the limitations of combined limitations of claims 1, 3 and 10 and are similarly rejected as above.

Response to Arguments

Applicant's arguments filed March 1, 2004 have been fully considered but they are not persuasive.

Applicant argues "the Examiner ...is not appreciated is that applicant has developed a new combination to produce a patent. The steps applicant has developed produces the most efficient method of identifying distinctly claiming and thereafter composing a patent application." Examiner agrees that the distinct process to produce a known product can by patentable. However, as explained in the rejections above, merely automating a known manual process of patent drafting would have been obvious to a person of ordinary skill in the art at the time of the invention.

Applicant asserts that "Just because the summary language in Takano matches the claim language does not suggest the step of getting it there nor does it suggest copying the claims into the description." Furthermore, Applicant argues that feature of "the sequence of reference numerals in automatically shifted when the order of occurrence of the elements in the description is changed, e.g., as by editing" is not obvious. However, Examiner disagrees. As Takano evidences, it was well known practice in the patent drafting art to use a copy of the claims to be incorporated into the Specification (e.g., Summary of Invention). Given that, it was also well known practice to

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shift the reference numerals whenever the specification is edited. The instant claim merely claims automating the well known practice that was done manually using the well known document automation technology. Thus, such automation would have been obvious to a person of ordinary skill in the art at the time of the invention in view of the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

After-final	(703) 746-7238
Official	(703) 746-7239
Non-Official/Draft	(703) 746-7240

Hand-delivered responses should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



Stephen Hong

Primary Examiner

May 17, 2004